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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,365	06/17/2008	James Bain	BAI-01/SYN.3282.US	3199
23508	7590	01/19/2010		
LUNDEEN & LUNDEEN, PLLC			EXAMINER	
2710 Louisiana			WRIGHT, GIOVANNA COLLINS	
HOUSTON, TX 77006			ART UNIT	PAPER NUMBER
			3672	
			NOTIFICATION DATE	DELIVERY MODE
			01/19/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/598,365	<b>Applicant(s)</b> BAIN, JAMES	
	<b>Examiner</b> GIOVANNA C. WRIGHT	<b>Art Unit</b> 3672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2009 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 15-16, 18-19, 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wardley 20020189863.

Referring to claim 15, Wardley discloses (see fig. 1) a shoe for use on the end of a work string within a well bore, the shoe comprising a generally cylindrical body having a first end ( at 3) adapted for connection to the work string and a second end ( at 5) including a nose portion; the nose portion including a rounded head distal to the body for advancement through the well bore and a plurality of blades (4) extending from the head towards the body; the body having thereupon a reaming portion ( 8) located behind the nose portion wherein the reaming portion comprises a plurality of discrete raised members to ream the bore.

Referring to claim 16, Wardley discloses the blades (4) include a cutting surface ( at 6) to assist in breaking through bridges.

Referring to claim 18, Wardley discloses wherein the raised members (8) are elongate and continuous.

Referring to claim 22, Wardley discloses wherein the nose portion (5) includes one or more ports (7).

Referring to claim 23, Wardley discloses a gauge portion (at 9) located furthest from the nose portion.

Referring to claims 24-26, Wardley discloses the gauge portion comprises a plurality of elongate blades (9) arranged helically along the body.

Referring to claim 27, Wardley discloses the shoe is constructed from a combination of relatively hard and relatively soft materials (paragraph 0050).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-14, 17, 19 -21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wardley '863 in view of Mabry 6808019.

Referring to claims 1,3-5, 8,17,19 -21 Wardley discloses (see fig. 1) a shoe for use on the end of a work string within a well bore, the shoe comprising a generally cylindrical body having a first end ( at 3) adapted for connection to the work string and a second end ( at 5) including a nose portion; the nose portion including a rounded head distal to the body for advancement through the well bore and a plurality of blades (4) extending from the head towards the body; the body having thereupon a reaming portion ( 8) located behind the nose portion wherein the reaming portion comprises a plurality raised members to ream the bore. Wardley does not disclose the members

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are mounted oppositely. Mabry teaches (see figs. 3-4) tear drop shaped raised members (26,28) each pair of raised members being mounted oppositely, in parallel and longitudinally along the body, wherein each adjacent pair of members provides a funnel comprising diverging edges of adjacent members and a channel that converges from one end to another. Mabry teaches the shape and mounting of the raised members helps to improve the flow (see col. 7, lines 16-25). As it would be advantageous to improve the flow around the reamer, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the reaming members disclosed by Wardley to be teardrop shaped and each pair mounted oppositely in view of the teachings of Mabry.

Referring to claim 2, Wardley discloses wherein the raised members (8) are elongate and continuous.

Referring to claim 7, Wardley discloses wherein the nose portion (5) includes one or more ports (7).

Referring to claim 9, Wardley discloses the blades (4) include a cutting surface (at 6) to assist in breaking through bridges.

Referring to claim 10, Wardley discloses a gauge portion (at 9) located furthest from the nose portion.

Referring to claims 11-13, Wardley discloses the gauge portion comprises a plurality of elongate blades (9) arranged helically along the body.

Referring to claim 14, Wardley discloses the shoe is constructed from a combination of relatively hard and relatively soft materials (paragraph 0050).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wardley '863 in view of Mabry 6808019 as applied to claim 1 above, and further in view of Herrera 20030106719.

Referring to claim 6, Wardley does not disclose the nose portion is eccentric. Herrera teaches that a nose portion on a shoe can be eccentric to facilitate progress of the casing past obstruction in the bore (paragraph 0003).

### ***Response to Arguments***

6. Applicant's arguments filed 10/7/09 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., tubing shoe for use after boring or drilling) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims broadly recite a shoe for use on the end of a workstring. As broadly claimed, Wardley discloses a shoe (see paragraph 0007, lines 10-11).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIOVANNA C. WRIGHT whose telephone number is (571)272-7027. The examiner can normally be reached on 7:30-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Giovanna C. Wright/  
Primary Examiner, Art Unit 3672